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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER NASH, LASHANYA RENEE	
			ART UNIT 2153	PAPER NUMBER

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/781,329	Applicant(s) FUKUMOTO ET AL.	
	Examiner LaShanya R Nash	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to an Amendment filed May 4, 2005. Claims 1-9 are presented for further consideration.

Response to Arguments

Applicant's arguments, see Remarks/Arguments II, filed December ay 4, 2005 have been fully considered but are not persuasive.

In considering the Applicant's arguments the following factual remarks are noted:

- (I) Applicant contends that Kohler does not show sending the same message to all recipients where different parts of the same email are highlighted for respective recipients.
- (II) Applicant contends that Krause does not discuss sending messages with parts important to different receivers highlighted or emphasized, and adds nothing to Kohler with respect to the features of the invention.

In considering (I), Applicant contends that applicants invention is distinct over Kohler as Kohler does not show sending the same e-mail message to all recipients where different parts of the same email are highlighted for respective recipients. Examiner respectfully disagrees. As asserted by applicant, Kohler discloses employing the content-specific email system so an entire

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message is sent to all of the intended recipients, (column 6, lines 59-62). Kohler additionally asserts highlighting the message portions for respective categories of recipients, (e.g. To:, cc:, and bcc: recipients), (column 7, lines 50-58; Figure 6). Therefore in this instance, an entire email message is received by all recipients, and portions of the message are highlighted for respective receivers based on the aforementioned category, as opposed to highlighting based on portions of the message not received by other recipients. Consistent with the practical example as presented by Applicant, a message contains portions B and C that are intended for a specific receiver among message portions A, B, C, and D. The functionality of applicants invention can be achieved through employing the content-specific system as disclosed by Kohler by: composing an e-mail with all portions to be received by all intended recipients (i.e. not deselecting users for certain portions; column 6, lines 57-67); placing an intended respective receiver in a category (e.g. To:; column 7, lines 26-40); and designating message portions A and B for that category, (column 7, lines 24-40). Message portions C and D are not deselected for transmission for an intended receiver, so the entire message (i.e. A, B, C, and D) is received by all recipients, while portions A and B are highlighted for a specified category. As a result, the Examiner affirms that the aforementioned recipient-specific emailing system is functionally equivalent to the applicant's claim invention, wherein the features described by applicant are achievable without modification to the system, as disclosed by Kohler.

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In considering (II), Applicant contends that Krause does not discuss sending messages with parts important to different receivers highlighted or emphasized, and adds nothing to Kohler with respect to the features of the invention. Examiner disagrees. Examiner maintains that Kohler teaches the claimed limitations, as addressed in regards to (I) above. Subsequently, Examiner maintains that dependent claims are unpatentable over Kohler in view of Krause.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, and 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Kohler (US Patent 6,192,396).

Kohler teaches an electronic messaging system that allows a sender to designate and highlight recipient-specific information, in order to eliminate sending identical messages with portions that may not be pertinent to certain recipients.

In reference to claim 1, Kohler shows that the E-mail system with recipient-specific content system includes:

- A receiving device receiving transmission information transmitted from a sender to a plurality of receivers, **"In operation, a user generates an E-mail message using one of the clients... The user then sends the E-mail message to recipients who have access to the E-mail clients of computerized messaging system 1...the message is communicated to E-mail server 6"** (column 3, line 63 to column 4, line 1 and Figure 1); and
- An emphasizing device emphasizing and highlighting different parts the transmission information for respective receivers, and preparing E-mail information including all of the transmission information, **"In the absence of contrary instructions entered by an author (i.e., as a default procedure), the entire message will be sent to all recipients designated in the list boxes"** (column 6, lines 58-62), with the transmission information in which the different parts are for respective receiver, **"The portions of the message itself may also appear colored, underlined or otherwise highlighted...so as to indicate that the highlighted portion has a limited list of recipients...Color coding or some other form of differential highlighting (such as multiple underlining) may also be employed as to show which different**

portions of a message are sent to different sets of recipients"(column 2, lines 33-49 and Figure 6);

- A transmitting device transmitting the E-mail information to respective receivers, **"The user then sends the E-mail message to recipients who have access to the E-mail clients of computerized messaging system 1..."**(column 3, lines 64-65).

In reference to claim 2, Kohler teaches emphasizing and receiving selected portions of electronic messages intended for specific users via computing devices. As previously discussed, the E-mail client/server computers as disclosed in the Kohler E-mail system support transmitting, receiving, and text emphasizing functions. Thus, the computers are functionally equivalent to the aforementioned devices. Kohler further shows the E-mail client/server computers as:

- Receiving device that receives a part of the transmission information that the sender designates and information about a corresponding transmission destination, **"...authoring a computerized message that contains recipient-specific content involves...identifying one or more recipients to which at least one portion of the message will be sent, and for each recipient associating at least one portion of the message..."**(column 2, lines 14-19); and
- Emphasizing device that emphasizes and highlights the designated part and prepares E-mail information for a receiver corresponding to

the transmission destination, "... **visual cues in message text area 51 and list boxes 47 through 49 preferably are provided to indicate which portions of the message are designated for which recipient...Other types of highlighting and other color schemes can be used to provide the foregoing visual cues...**"(column 7 lines 40-60 and Figure 6), "**E-mail editor generates separate messages corresponding to each subset of identified recipients**"(column 11, lines 30-32).

In reference to claim 4, Kohler teaches a client/server computer terminal apparatus employed in the aforementioned electronic messaging system (column 4, lines 31-54 and Figure 2). The disclosed terminal apparatus comprises:

- A transmitting device transmitting transmission information prepared for a plurality of receivers, "**Network interface 17 provides an interface between computer system 10 and network...Thus, network interface 17 provides computer system 10 with access to computerized messaging system**"(column 4, lines 51-54 and Figure 2); and
- An indication device indicating E-mail information that emphasizes and highlights different parts of the transmission information for respective receivers; preparing E-mail information for respective receivers including all of the transmission information; "**Provided with computer system 10 are...pointing device such as a**

mouse for pointing and to and for manipulating graphical user interfaces and other objects...(column 4, lines 40-44 and Figure 2), **"In order to generate a message, a user manipulates items in an E-mail window using a cursor controlled with pointing device 14...focus indicator follows the cursor, any text through which the focus indicator passes is highlighted"**(column 6, lines 13-30 and Figure 6); and transmitting the E-mail information for respective receivers, with all of the transmission information sent to respective receivers, **"In the absence of contrary instructions entered by an author (i.e., as a default procedure), the entire message will be sent to all recipients designated in the list boxes "**(column 6, lines 58-62).

In reference to claim 5, Kohler discloses that, "computer system 10 also includes a mass storage device such as a fixed disk 15 for storing computer executable process steps for E-mail applications..." (column 4, lines 44-49 and Figure 4). These E-mail applications, specifically the E-mail editor and reader software, provide the various functions of the messaging system (column 5, lines 19-30). As applied to previous claims, functions of the electronic mail system, as shown by Kohler, include: receiving transmission information from a sender to a plurality of receivers; emphasizing and highlighting the different parts of transmission information for each receiver; preparing E-mail information for

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respective receivers; and transmitting the E-mail information for respective receivers. Therefore, Kohler teaches a system comprising executable code that specifically implements the previously stated functions. This is equivalent to the software program disclosed by the applicant.

In reference to claim 6, Kohler shows a method comprising:

- Preparing transmission information to be transmitted from a sender to a plurality of receivers, **"E-mail editor is carrying out the foregoing authoring operation... In step S1101, E-mail editor 31 accepts portions of a message (i.e., text/and or attachments) entered by a user...In step S1104 identification of recipients from the list is accepted"**(column 10, lines 53-61 and Figure 11); and
- Emphasizing and highlighting the transmission information for respective receivers, **"...flow then proceeds to step S1108, where visual cues are provided indicating the associations between portions of the message and recipients. These visual cues can be in the form of underlining, color schemes, or other forms of highlighting"**(column 11, lines 5-9 and Figure 11);
- Preparing E-mail information for respective receivers, **"In step S114, E-mail editor generates separate messages corresponding to each subset of identified recipients"**(column 11, lines 30-32 and Figure 11);
- Transmitting the E-mail information including all of the transmission information, **"In the absence of contrary instructions entered by an**

author (i.e., as a default procedure), the entire message will be sent to all recipients designated in the list boxes ”(column 6, lines 58-62),
respective receivers, “**... command has been given to send the message...**”(column 11, lines 28-29 and Figure 11);

- Emphasizing and displaying the transmission information for respective receivers, “**In steps S1301, E-mail reader 32 displays text and icons for attachments for a message, preferably including visual cues...**”(column 11, lines 62-65 and Figure 13).

In reference to claim 7, Kohler explicitly discloses:

- Receiving means for receiving transmission information transmitted from a sender to a plurality of receivers, transmitting means for transmitting the E-mail information for each receiver, “**Network interface 17 provides computer system 10 with access to computerized messaging system 1**”(column 4, lines 51-54 and Figure 2), “**...user sends the E-mail message to recipients who have access to the E-mail clients of computerized messaging system 1**”(column 3, lines 63-67); and
- Emphasizing means for emphasizing and highlighting the transmission information for respective receivers, and preparing e-mail information for respective receivers, “**As shown in Fig.3, computer system 10 includes central processing unit (CPU)...main memory (RAM) 21, ...Main memory 21 interfaces**

with computer bus 20 so as to provide RAM storage to CPU 19 during execution of software applications"(column 4, line 55 to column 5, line 1 and Figure 3); and

- Transmitting the E-mail information including all of the transmission information, **"In the absence of contrary instructions entered by an author (i.e., as a default procedure), the entire message will be sent to all recipients designated in the list boxes"**(column 6, lines 58-62), to respective receivers; **"... the author instructs the message to be sent, and the appropriate portions are sent to the appropriate respective recipients"**(column 10, lines 5-16).

In reference to claim 8, Kohler discloses the E-mail system with recipient-specific content system includes:

- A system (Figure 1) for propagating a signal from a propagating computer (i.e. E-mail server; Figure 1-item 6) to receiver computers, (i.e. E-mail clients; Figure 1-item 2-5), **"Computers systems 2 through 6 are connected to each other through network 7"**(column 2, lines 49-62), the propagating computer of the system comprising a program, **"system 10 also includes a mass storage device such as a fixed disk 15 for storing computer executable process steps for E-mail applications..."** (column 4, lines 44-49 and Figure 4).

These E-mail applications, specifically the E-mail editor and reader software, provide the various functions of the messaging system (column 5, lines 19-30). As applied to previous claims, functions of the electronic mail system, as shown by Kohler, include: receiving transmission information from a sender to a plurality of receivers; emphasizing and highlighting the different parts of transmission information for each receiver; preparing E-mail information for respective receivers; and transmitting the E-mail information including all of the transmission information to respective receivers.

In reference to claim 9, Kohler explicitly discloses a method for recipient-specific content emailing, (Figures 10-13). Kohler discloses the method to comprise:

- Receiving information for different destinations with the information having different parts, “ **a user composes the method, identifies one or more recipients to whom at least one portion of the message will be sent.**”(column 9, line 65 to column 10, line 3);
- Emphasizing the different parts responsive to the destinations, “**visual cues in message text area 51 and list boxes 47 through 49 preferably are provided to indicate which portions of the message are designated for which recipient**”(column 7, lines 40-50);

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- Sending all of the information by email to the destinations with each destination receiving all of the information, **"In the absence of contrary instructions entered by an author (i.e., as a default procedure), the entire message will be sent to all recipients designated in the list boxes "**(column 6, lines 58-62), to with at least one of the parts emphasized responsive to the destination; and displaying the information with one of the parts emphasized at at least one of the destinations, **"Once the user is satisfied with the message, the author instructs the message to be sent, and the appropriate portions are sent to the appropriate recipients. The recipient can view the received message with portions highlighted..."**(column 10, lines 6-16).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kohler as applied to the claims above, and further in view of Krause et al (US Patent 6,154,757). Kohler shows substantial features of the claimed invention, as previously addressed. However, Kohler does not teach a storing device storing

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keyword information predetermined for each receiver and subsequently highlighting these keywords included in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Kohler as evidenced by Krause.

In an analogous art, Krause discloses an electronic text reading environment enhancement method and apparatus in which designated words and phrases can be emphasized in an electronic text (column 3, lines 59-63). Specifically, Krause shows a wordlist comprised of various words and phrases for the user (column 7, lines 19-38 and Figure 3). The contents of the wordlist are highlighted within displayed electronic text (column 29, lines 48-52 and Figure 14).

Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail system disclosed by Nelson, in order for the recipient to maximize their speed and comprehension in reading electronic mail content (Krause column 3, lines 24-26).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (571) 272-3957. The examiner can normally be reached on 9am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShanya Nash
Art Unit, 2153
June 23, 2005

JN


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